

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK AND APPEAL BOARD

IN THE MATTER OF TRADEMARK REGISTRATION NO. 2,372,585  
Registered August 1, 2000

BOYDS COLLECTION, LTD.,  
Petitioner,

v.

HERRINGTON & COMPANY, INC.,  
Registrant.

Cancellation No. 32,146

10-10-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Mark: TBC HERRINGTON'S TEDDY  
BEAR CLUB & Design

Registration No.: 2,372,585

Registration Date: August 1, 2000

REGISTRANT'S REPLY TO PETITIONER'S RESPONSE TO MOTION TO STRIKE

After receiving the Motion to Strike filed by Registrant HERRINGTON & COMPANY, INC. ("Registrant") in the above captioned action, Petitioner BOYDS COLLECTION, LTD. ("Petitioner") filed a brief in opposition to the Motion to Strike on September 26, 2002 (the "Response"). Registrant requests that the Board consider this reply under TBMP § 502.03, to permit Respondent to respond to the new issues and/or materials submitted in Petitioner's Response.

**A. Registrant's Objections Are Appropriate and Timely.**

As noted in the Motion to Strike, Registrant was never given notice of the deposition (by way of declaration) or the opportunity to cross-examine Ms. Ausherman. As such, the Notice of Reliance was the first time that Registrant saw or heard of the deposition/declaration. Therefore, to preserve the record and its rights herein, Registrant moved to strike and made the necessary objections to the deposition of Ms. Ausherman under TBMP §§ 718.02(c) and 718.03; and Fed. R. Civ. Prod. 32(d).

It should be noted that certain objections to depositions must be raised promptly, failing which they are waived. TBMP § 718.03 *et seq.* Thus, not only were Registrant's objections and request to strike the Ausherman Declaration timely raised they were required to be raised under the Trademark Rules.

**B. The Documentary Evidence Does Not Fall Under Printed Publications.**

Petitioner contends in the Response that even if the Ausherman Declaration is inadmissible, the documents contained in the Notice of Reliance in Exhibits B through L (the "Documentary Evidence") are still admissible as "printed publications" under 37 C.F.R. § 2.122(3). However, the Documentary Evidence does not fall under the definition for "Printed Publications," and thus, is inadmissible as a whole.

The Trademark Rules provide a special procedure for the introduction of printed documents of *wide public availability* (italics added). 37 C.F.R. § 2.122(e); TBMP § 708. However, this provision extends only to publications "available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding" and does not extend to catalogues, commercial brochures and other items clearly not available to the general public. Glamorene Products Corporation v. Earl Grissmer Company, Inc., 203 U.S.P.Q. 1090 (TTAB 1979) (finding that the section was not intended to be construed as an indication that an individual company's promotional literature, product booklets, annual reports, etc. are admissible under the section).

In the Documentary Evidence, Petitioner has identified Exhibits as B through L: (1) price sheets in Exhibits C and D and (2) catalogues in Exhibits A and E through L. Price sheets and catalogues do not fall under the definition of "printed publications" as they are not documents of wide public availability. Exhibits B-L contain Petitioner's promotional literature and price sheets that under Glamorene cannot be considered printed publications and require proper evidentiary authentication for admission. Further, products, product labels and trade dress (as shown in certain of the catalogues), likewise, do not fall under the definition of "publications," See 3 Jerome Gilson, TRADEMARK PROTECTION AND PRACTICE § 9.02[5][c] at note 380. The Documentary Evidence cannot be admitted without a supporting declaration for proper foundation and authentication (which Registrant maintains the Ausherman Declaration fails to provide) or by stipulation of the parties (which has not occurred). Because none of the Documentary Evidence falls under the definition of "printed publications" and because the Ausherman Declaration fails and, thus, cannot be used to properly authenticate any of the Documentary Evidence, the Documentary Evidence is inadmissible as it fails to comply with

the procedural requirements for its submission as evidence.

It is undisputed that Petitioner has not taken any discovery in this case. Thus, the Documentary Evidence does not contain any discovery documents or produced documents in this action and, thus, cannot be submitted under 37 C.F.R. § 2.120(j), which allows for the introduction into evidence by a notice of reliance of, among other things, certain produced documents under certain conditions, pursuant to 37 C.F.R. § 2.122(e).

**C. Exhibits B-L Not Properly Labeled.**

Petitioner contends that “37 C.F.R. § 1.123,” the rule requiring that exhibits be properly labeled, cannot be found in the Federal Register or it Lexis search for the rule. Registrant submits that there was a typographical error in this citation in its motion papers and the rule, which clearly exists, should have been cited as “37 C.F.R. § 2.123.”<sup>1</sup> Registrant apologizes for this error.

**D. Prejudice to Registrant.**

Petitioner contends that the late service of the Notice of Reliance on Registrant is not prejudicial to Registrant because the TTAB may reset the time period for Registrant to respond and submit testimony to rectify any prejudice caused by the four (4) month delay in the service of the Notice of Reliance on Registrant.

Registrant submits that although such an equitable remedy *might* alleviate some of the prejudice conferred on Registrant in connection with filing a response to the notice and taking its own testimony, no remedy exists to cure the prejudice bestowed by Petitioner’s failure to allow Registrant any opportunity to cross-examine the witness. Registrant has not been given an opportunity to examine Ms. Ausherman on the record on her purported statements and opinions, as required by 37 C.F.R. § 2.123(e)(3) and TBMP § 713.08

Petitioner failed to give any notice to Registrant of the “deposition” (by way of declaration) of Ms. Ausherman. As a result, Registrant has been harmed and prejudiced by

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<sup>1</sup> Title 37 of the Code of Federal Regulations § 2.123(g)(2) states: “Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused for improperly marked exhibits.” 37 C.F.R. § 2.123(g)(2).

Petitioner's failure to give Registrant any opportunity to cross-examine the witness as required by TBMP § 713.08 and 37 C.F.R. § 2.123(e)(3). On this basis alone, the Ausherman Declaration is inadmissible as a whole. TBMP § 718.03(c).

Furthermore, no remedy has been offered by Petitioner to cure or even alleviate such harm or the substantial expense incurred by Registrant in correcting and responding to Petitioner's failure to comply with the Board's rules and evidentiary requirements. Petitioner's has proffered no excusable explanation for its repeated errors in this action.

**E. Conclusion.**

In light of the foregoing, Registrant respectfully maintains its request that the Board strike the Notice of Reliance as a whole, and/or separately, strike the Ausherman Declaration in its entirety. The Board's rules exist for the purpose of, among other things, enforcement. In this case, we respectfully request that the Board enforce the relevant provisions of the Trademark Rules and the Code of Federal Regulations and strike the Notice of Reliance in whole as it fails to comply with any of the procedural rules under which it was submitted.

Dated: October 10, 2002

Respectfully submitted,

**HERRINGTON & COMPANY, INC.**

By: 

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P. Craig Cardon

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Attorneys for Registrant

CERTIFICATE OF SERVICE

I hereby certify that on October 10, 2002, I served a copy of the foregoing REGISTRANT'S REPLY TO PETITIONER'S RESPONSE TO MOTION TO STRIKE upon petitioner Boyds Collection, Ltd.'s counsel of record, Michael J. Cherskov, Esq., by mailing a true and correct copy thereof by postage prepaid First Class United States Mail to the following address:

Michael J. Cherskov  
CHERSKOV & FLAYNIK  
The Civic Opera Building, Suite 1447  
20 N. Wacker Drive  
Chicago, IL 60606

DATED: October 10, 2002

By: Sadie Lum  
Name: Sadie Lum

Express Mail mailing label No. **EL 952564506 US**

Date of Deposit **October 10, 2002**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Sadie Lum

(Type or Print Name of Person Mailing Paper or Fee)

*Sadie Lum*

(Signature of Person Mailing Paper or Fee)

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Attorneys for Registrant

October 10, 2002

**BY U.S. EXPRESS MAIL**

10-10-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513  
Attention: Legal Assistant, TTAB

**Re: Cancellation No.: 32,146**  
**Mark: TBC HERRINGTON'S TEDDY BEAR CLUB & Design**  
**Registration No.: 2,372,585**  
**Registration Date: August 1, 2000**  
**Registrant: Herrington & Company, Inc.**  
**Our Ref.: 40362.6**

02 OCT 26 PM 9:30  
TTAB

Dear Sir or Madam:

Enclosed herewith is Registrant's Reply to Petitioner's Response to Motion to Strike for the above referenced matter. So that we may have a timely record of receipt of the enclosed, please date-stamp the enclosed, stamped, self-addressed post card, and deposit it into the U.S. mail.

Please direct all correspondence regarding this matter to my attention.

Very truly yours,



Elizabeth Moreno McArthur  
Attorney at Law

EMM/sl

Enclosure

Copy: P. Craig Cardon